UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014

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EXAMINER
LY, ANH

ART UNIT	PAPER NUMBER
2172	

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/900,551	CHASTAIN ET AL.
		Examiner	Art Unit	
		Anh Ly	2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 July 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This Office Action is response to Applicants' communication filed on 07/06/2001.

2.   Claims 1-27 are pending in this application.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 1-2, 9-12, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 5,835,758 issued to Nochur et al. (hereinafter Nochur

in view of US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager).

With respect to claim 1, Nochur discloses receiving a user input selecting the text from the electronic book to form selected text (the user enters the text document and selects the desired text to be transferred: col. 7, lines 42-65 and col. 11, lines 42-53).

Nochur discloses a distributed computer system comprising a plurality of computer-based documents, which can be shared among various users on the network. The text document or selected text can be sent or forwarded to other users or recipients who are listed from a list of people available in database and are selected by the sender (col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach automatically sending the selected text to a designated set of recipients in response to receiving the user input selecting the text.

However, Hager discloses the selected text or document is automatically transmitted to the preselected recipients (col. 2, lines 25-38 and col. 4, lines 25-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur with the teachings of Hager so as to obtain a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) over a computer network within data processing system.

With respect to claim 2, Nochur discloses displaying a list wherein the designated set of recipients is selected from the list (col. 9, lines 61-67 and col. 10, lines 1-10).

With respect to claims 9-12, Nochur discloses wherein the sending step sends the highlighted text to the designated set of recipients using a communications link; wherein the sending step sends the highlighted text to the designated set of recipients in an electronic mail message; wherein the highlighted text is located in a body of the electronic mail message and wherein the highlighted text is located in an attachment attached to the electronic the electronic mail message (see abstract, communications link over the network: col. 5, lines 28-54 and computer message sending over the network is a electronic mail message: col. 7, lines 10-67).

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 27 is essentially the same as claim 1 except that it is directed to a computer program product in a computer readable medium rather than a method, and is rejected

6.   Claims 3-8, 13-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 5,835,758 issued to Nochur et al. (hereinafter Nochur

in view of US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager) and

further in view of Patent No. 5,893,132 issued to Huffman et al. (hereinafter Huffman).

        With respect to claims 3-8, Nochur in view of Hager discloses a method in a data

processing as discussed in claim 1.

        Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach

automatically sending the selected text to a designated set of recipients in response to

receiving the user input selecting the text. Hager teaches automatically sending the

selected to a designated set of recipients. In combination, Nochur and Hager do not

teach highlight text, text in a different color from unselected text, data structure,

download file, text in electronic book.

        However, Huffman discloses wherein the selected text is highlighted text. (col.

19, lines 1-20 and col. 23, lines 25-36); wherein the highlighted text is text in a different

color from unselected text, bolded text, and text with a different font type from

unselected text (col. 23, lines 25-36); storing the highlighted text in a data structure

(web page having HTML or hyperlinks or hypertext: col. 19, lines 1-20; also see col. 16,

lines 5-14); wherein data structure is a download file (download the text files: col. 12,

lines 55-67); wherein the text is a notated passage of text in the electronic book (col. 2,

lines 32-42); wherein the text is a highlighted passage of text in the electronic book

(col. 19, lines 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Nochur in view of Hager

with the teachings of Huffman so as to obtain a hand-held electronic reading devices

incorporating with user interface, which allows a user to navigate through the textual

information and access various features of electronic reading device (col. 2, lines 24-42

and col. 16, lines 5-14); highlight feature in the electronic book and performing different

fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col.

23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and

sending or transmitting the text to the user (col. 6, lines 26-36). This combination would

have made a method in a data processing system being able to create or select a text

document in order for automatically sending or forwarding to the receiver(s) (Hager –

abstract) and a method for distributed the selected text document with a desired

recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10)

over a computer network within data processing system.

With respect to claim 13, Nochur discloses receiving a first user input selecting

the text from the electronic book to form selected text (the user enters the text

document and selects the desired text to be transferred: col. 7, lines 42-65 and col. 11,

lines 42-53), displaying a list of recipients (col. 9, lines 61-67).

Nochur discloses a distributed computer system comprising a plurality of computer-based documents, which can be shared among various users on the network. The text document or selected text can be sent or forwarded to other users or recipients who are listed from a list of people available in database and are selected by the sender (col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach automatically sending the selected text to a designated set of recipients in response to receiving the user input selecting the text.. Hager teaches the selected text or document is automatically transmitted to the preselected recipients (col. 2, lines 25-38 and col. 4, lines 25-37). In combination, Nochur and Hager do not explicitly indicate receiving a second user input.

However Huffman discloses receiving a second user input (col. 17, lines 45-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager –

abstract) and a method for distributed the selected text document with a desired

recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10)

over a computer network within data processing system.

With respect to claim 14, Nochur discloses receiving selected text from at least

one electronic book through a communications link (see abstract and col. 7, lines 10-

67)., and displaying the text or selected text (col. 8, lines 12-24 and col. 9, lines 1-12).

Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10) and sorting the data and displaying the data.

Nochur does not explicitly teach sorting the selected text using selection criteria to form

sorted text. Hager teaches sorting the text based on criteria such as functional area field

of a file (col. 7, lines 55-65). In combination, Nochur and Hager do not teach highlighting

the portion of the electronic book based n the user input.

However, Huffman discloses wherein the selected text is highlighted text. (col.

19, lines 1-20 and col. 23, lines 25-36; web page having HTML or hyperlinks or

hypertext: col. 19, lines 1-20; also see col. 16, lines 5-14 and col. 19, lines 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Nochur in view of Hager

with the teachings of Huffman so as to obtain a hand-held electronic reading devices

incorporating with user interface, which allows a user to navigate through the textual

information and access various features of electronic reading device (col. 2, lines 24-42

and col. 16, lines 5-14); highlight feature in the electronic book and performing different

fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col.

23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and

sending or transmitting the text to the user (col. 6, lines 26-36). This combination would

have made a method in a data processing system being able to create or select a text

document in order for automatically sending or forwarding to the receiver(s) (Hager –

abstract) and a method for distributed the selected text document with a desired

recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10)

over a computer network within data processing system.

With respect to claim 15, Nochur discloses wherein retrieving step

retrieves the highlighted text for the electronic book from another user using a

communications link (see abstract).

With respect to claims 16-17 and 20-22, Nochur discloses the sorted text and

displaying the sorted text (sorting the data: col. 5, lines 60-65; displaying the data: col.

8, lines 12-24 and col. 9, lines 1-12).

With respect to claims 18-19, Nochur in view of Hager discloses a method as

discussed in claim 14.

In combination, Nochur and Hager do not discloses electronic book including

selected text with annotations made by a user.

However, Huffman discloses wherein the selected text includes passages from at least one electronic book; and wherein the selected text includes annotations made by a user (col. col. 6, lines 25-36col. 7, lines 30-46 and col. 16, lines 4-12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) and a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10) over a computer network within data processing system.

Claim 24 is essentially the same as claim 13 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 13 hereinabove.

Claim 25 is essentially the same as claim 14 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 14 hereinabove.

Contact Information

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is 703 306-4527 or via E-Mail: ANH.LY@USPTO.GOV. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on 703 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703 746-7239.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: Central Office (703) 872-9306 (effective from 08/04/2003)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-6606 or 703 305-3900.

AL
JAN. 7th, 2004